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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,148	10/29/2003	Eng-Keong Lee	IT-03-006	5487
40604	7590	09/19/2007	EXAMINER	
INTER-TEL, INC. 7300 WEST BOSTON STREET CHANDLER, AZ 85226			WALSH, JOHN B	
			ART UNIT	PAPER NUMBER
			2151	
			MAIL DATE	DELIVERY MODE
			09/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,148

Applicant(s)

LEE, ENG-KEONG

Examiner

John B. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amdt of 6/3/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Declaration filed on February 14, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Appelman et al. '963 reference.
2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Appelman et al. '963 reference to either a constructive reduction to practice or an actual reduction to practice. The applicant's filing date is October 29, 2003. The applicant has provided Exhibits A and B dated August 26, 2002 and October 1, 2002 (revision Oct. 25, 2002) respectively. These exhibits are more than one year prior to applicant's filing date. The applicant has not provided sufficient evidence to establish due diligence of why the application was filed more than one year after submitted evidence to establish reduction of practice.
3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Appelman et al. '963 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). It is unclear where support for the claim limitation of "unbeknownst to the contact" is disclosed in the exhibits. Furthermore, the applicant has not provided any evidence that associates the submitted exhibits with the inventor of the present application. The documents do not provide any indication of the

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associated participants/inventors for these documents, particularly the inventor of the present application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4-9 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0196963 to Appelman et al.

As concerns claim 1, an endpoint status notification system for use in a telecommunications network, the system comprising: an address book (0068, page 7, line 15) comprising a plurality of network user's names (names in address book) and their associated endpoints (address); a personal list of contacts comprising the users selected from the address book by one of the users (users selected from book and inserted into a message send to line); an instant message alert (0068:0004; 0008) received by said one user upon every occurrence of a reportable event for the contacts on the list, the alert comprising one of a plurality of viewable (figure 3B) informational status messages pertaining to the contact and delivered to said one user unbeknownst to the contact (sender does not know if receiver is available; figure 14, 15A-recipient specified), the reportable event being selected by said one user for each of the contacts on the list, whereby the reportable events received by said one user may differ for each of the contacts on the personal list; and a viewable call-control option received by said one user

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simultaneous with the instant message alert and selection of said option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur (330;0008; email, inherently viewable, sent to a user informing them of some information).

As concerns claim 4, the system of claim 1, wherein one of the contacts on the personal list comprises said one user, thereby said one user receiving the instant message alert for every occurrence of reportable event for said one user (0009; for each message received an alert is sounded).

As concerns claim 5, the system of claim 1, wherein the instant message alert is received for a preset amount of time to be determined by said one user (0009, length of audio message may be longer or shorter based on user's audio selection).

As concerns claim 6, the system of claim 1 further comprising a log of the reportable events for said one user and viewable by said one user sometime after the event occurs (0054; column 2, line 1).

As concerns claim 7, the system of claim 1, wherein the personal list of contacts further comprises a textual display of a current status of the contacts, the list being viewable by said one user and updated immediately following a reportable event, whereby said one user is able to view a real-time status of the contacts (figure 1; users have a display/monitor for viewing the contacts in the address book(0068); 0075).

As concerns claim 8, the system of claim 1, wherein said one user proxies another user to receive the instant message alerts intended for said one user (0151; forward message).

As concerns claim 9, a method of endpoint status notification system in a telecommunications network comprising a plurality of users, the method comprising: selecting a list of personal contacts from an address book (0068, page 7, line 15) comprising names (names in address book) and endpoints (address) belonging to the users; for each of the contacts, choosing one or more telephony-related reportable events associated with the contact (0008; email sent to a user informing them of some information), whereby the reportable events for each contact may differ; receiving a message alert instantaneously upon occurrence of the telephony-related reportable event and transmitted unbeknownst to the contact (0068;0004; 0008); viewing the alert comprising an informational message and a call-control option, both pertaining to a real-time status of one of the contacts (figure 3b); selecting the call-control option to initiate a telephony-related function to the contact (figure 3b).

As concerns claim 11, the method of claim 9, wherein viewing the alert comprises viewing a popup window (0066) for a pre-determined time limit (time determined by user until they close the window).

As concerns claim 12, the method of claim 9 further comprising viewing a menu of telephony-related reportable events (0069) for each contact prior to choosing the reportable events.

As concerns claim 13, the method of claim 12 further comprising viewing the list of personal contacts (0068, page 7, line 15) and a real-time status of each contact displayed near each name (0068).

As concerns claim 14, a method for status notification in a telecommunications network comprising a plurality of endpoints, the method comprising: detecting a change in status of a

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monitored endpoint (user composes a message); determining if the change is an identified reportable event for the monitored endpoint (user sends message); if the change is the identified reportable event, then immediately transmitting a status alert to a user, unbeknownst to the monitored endpoint (sender does not know if receiver is available; figure 14, 15A-recipient specified), requesting notification of the identified reportable event (figure 3b); transmitting, simultaneous with the status alert, one or more viewable call processing commands related to the identified reportable event and the monitored endpoint (figure 3b); and processing the call command associated with the monitored endpoint (user selects from figure 3b).

As concerns claim 15, the method of claim 14, wherein determining comprises comparing the change to a pre-selected and stored reportable event for the monitored endpoint (computer has stored instructions for functions to perform for a condition, a change in the condition is compared to a default condition).

As concerns claim 16, the method of claim 14, wherein transmitting a status alert comprises transmitting and displaying a popup window (0066).

As concerns claim 17, the method of claim 14, further comprising causing an audible alert (0009) to indicate the identified reportable event.

As concerns claim 18, the method of claim 14, wherein reportable events vary for each monitored endpoint (events may vary in the time that they are delivered).

6. Claims 1, 2, 4-9 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,553,341 B1 to Mullaly et al.

As concerns claim 1, an endpoint status notification system for use in a telecommunications network, the system comprising: an address book (col. 7, line 2)

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comprising a plurality of network user's names (names in address book) and their associated endpoints (address); a personal list of contacts comprising the users selected from the address book by one of the users (users selected from book and inserted into a message send to line); an instant message alert (col. 2, lines 36-43) received by said one user upon every occurrence of a reportable event for the contacts on the list, the alert comprising one of a plurality of viewable (col. 7, line 25, 34; col. 8, lines 53-54) informational status messages pertaining to the contact and delivered to said one user unbeknownst to the contact (col. 7, line 30; col. 8, lines 23-24), the reportable event being selected by said one user for each of the contacts on the list, whereby the reportable events received by said one user may differ for each of the contacts on the personal list (col. 10, lines 10-13); and a viewable call-control option received by said one user simultaneous with the instant message alert and selection of said option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur (figure 8; column 8, lines 3-13).

As concerns claim 2, wherein said instant message alert comprises a popup window on a display of an endpoint of said one user (col. 8, lines 53-56).

As concerns claim 4, the system of claim 1, wherein one of the contacts on the personal list comprises said one user, thereby said one user receiving the instant message alert for every occurrence of reportable event for said one user (column 8, lines 27-29).

As concerns claim 5, the system of claim 1, wherein the instant message alert is received for a preset amount of time to be determined by said one user (col. 7, lines 30; users selection may vary in length of time).

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As concerns claim 6, the system of claim 1 further comprising a log of the reportable events for said one user and viewable by said one user sometime after the event occurs (504).

As concerns claim 7, the system of claim 1, wherein the personal list of contacts further comprises a textual display of a current status of the contacts, the list being viewable by said one user and updated immediately following a reportable event, whereby said one user is able to view a real-time status of the contacts (col. 6, line 63-col. 7, line 2).

As concerns claim 8, the system of claim 1, wherein said one user proxies another user to receive the instant message alerts intended for said one user (figure 7, forwarding).

As concerns claim 9, a method of endpoint status notification system in a telecommunications network comprising a plurality of users, the method comprising: selecting a list of personal contacts from an address book (col. 6, line 63-col. 7, line 2) comprising names (names in address book) and endpoints (address) belonging to the users; for each of the contacts, choosing one or more telephony-related reportable events associated with the contact (figure 8), whereby the reportable events for each contact may differ (col. 10, lines 10-13); receiving a message alert instantaneously upon occurrence of the telephony-related reportable event and transmitted unbeknownst to the contact (col. 7, line 30; col. 8, lines 23-24); viewing the alert comprising an informational message and a call-control option, both pertaining to a real-time status of one of the contacts (figure 8); selecting the call-control option to initiate a telephony-related function to the contact (column 8, lines 3-13).

As concerns claim 11, the method of claim 9, wherein viewing the alert comprises viewing a popup window (col. 8, lines 53-56) for a pre-determined time limit (time determined by user until they close the window).

As concerns claim 12, the method of claim 9 further comprising viewing a menu of telephony-related reportable events (figure 7) for each contact prior to choosing the reportable events.

As concerns claim 13, the method of claim 12 further comprising viewing the list of personal contacts and a real-time status of each contact displayed near each name (col. 6, line 63-col. 7, line 2).

As concerns claim 14, a method for status notification in a telecommunications network comprising a plurality of endpoints, the method comprising: detecting a change in status of a monitored endpoint (col. 2, lines 36-43); determining if the change is an identified reportable event for the monitored endpoint (col. 2, lines 36-43; figures 7 and 8); if the change is the identified reportable event, then immediately transmitting a status alert to a user, unbeknownst to the monitored endpoint (col. 7, line 30; col. 8, lines 23-24), requesting notification of the identified reportable event (col. 5, line 66); transmitting, simultaneous with the status alert, one or more viewable call processing commands related to the identified reportable event and the monitored endpoint (column 8, lines 3-13); and processing the call command associated with the monitored endpoint (figure 6; col. 7, line 61-col. 8, line 13).

As concerns claim 15, the method of claim 14, wherein determining comprises comparing the change to a pre-selected and stored reportable event for the monitored endpoint (column 8, lines 23-40).

As concerns claim 16, the method of claim 14, wherein transmitting a status alert comprises transmitting and displaying a popup window (col. 8, lines 53-56).

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As concerns claim 17, the method of claim 14, further comprising causing an audible alert (col. 5, line 66) to indicate the identified reportable event.

As concerns claim 18, the method of claim 14, wherein reportable events vary for each monitored endpoint (col. 10, lines 10-13).

Response to Arguments

7. Applicant's arguments filed June 3, 2007 have been fully considered but they are not persuasive.

As concerns the applicant's arguments of the Declaration under 37 CFR 1.131, Exhibits A and B of the applicant's declaration fail to set forth the evidence of facts that support the claimed invention. The applicant has not identified where the claimed elements are supported throughout Exhibits A and B. Furthermore in the alternative that these exhibits support the claimed invention, they appear to establish a statutory bar since the claimed invention would have been set forth in a published document more than one year prior to applicant's filing date. Exhibit C is dated August 2003, which is not prior to the effective date of the Appelman et al. reference.

The applicant argues Mullaly does not disclose a viewable call-control option received simultaneous with the alert. Mullaly discloses this limitation at least at col. 7, lines 20-41, wherein an audible alert and viewable "call-control option" are displayed simultaneously.

The applicant argues Mullaly does not disclose a "call control option" as disclosed and claimed by the Applicant. The applicant's argument of a disclosed "call control option" is not

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persuasive since limitations from the specification are not read into the claims. Mullaly discloses a "call control option" at least at column 7, line 60-column 8, line 13 and figure 6.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., displays the informational status message pertaining to the contact) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

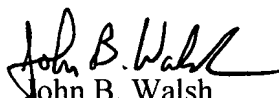
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John B. Walsh
Primary Examiner
Art Unit 2151